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Attorney Docket No. VID-01202/29

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Posa et al.

Serial No.: 09/625,531

Group No.: 2682

Filed: July 26, 2000

Examiner: E. Orgad

For: REMOTE MICROPHONE TELECONFERENCING CONFIGURATIONS

APPELLANTS' REPLY BRIEF

Mail Stop APPEAL BRIEF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This reply brief responds to new issues raised by the Examiner in the Examiner's answer mailed November 16, 2004.

First, on page 5, under "Response to Argument," the Examiner contends that "Appellant agrees with Examiner that all the limitations of claim 8 are met." This is absolutely **not true**. Indeed, in Appellant's brief, and in the record overall, it was argued that the limitations of claim 8 are not met, and that the proposed combination of David and Chang is erroneous and without foundation.

The Examiner goes on to argue, for the first time, that it would be proper to combine David and Chang "because both systems are used in a conference call setting and therefore analogous arts." However, just because two pieces of prior art are analogous – or not – is not sufficient reason to combine the references. Additionally, there must be some teaching from the references pointing to the combination, otherwise prima facie obviousness has not been established. As argued previously, David concerns audio switching, and has nothing to do with video. Nevertheless, the Examiner now argues that one of skill in the art would "find motivation in Chang" to add video capabilities to David because Chang's invention enhances video tracking while talking in a conference call. It is irrelevant to David how Chang modifies video tracking but rather that Chang

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teaches the video capabilities in a conference call is well known in the art.” Appellant continues to vigorously disagree, pointing out that this is the *wrong standard*. In particular, the Examiner states that one of skill in the art would “find motivation in Chang to add video capabilities . . .” but does not state where in Chang this motivation might be found. Without such evidence, the claims at issue are allowable.

The Examiner goes on to state that “David’s invention is a great invention . . .”. Not only does this show bias on the part of the Examiner, but whether or not a particular piece of art is “great” or not is absolutely irrelevant. As far as Appellant is concerned, the instant invention is “great.” The Examiner raises a new argument that “It would be completely obvious to take certain features from Chang’s invention and utilize them in David’s and vice versa.” Says who? This is clearly not the standard for establishing prima facie obviousness, and Appellant cannot believe that the Examiner, conferees Kincaid (a primary examiner) and Naymaung (a supervisory patent examiner) have read these arguments about David’s invention being “great” and that it would have been “completely obvious” to go back and forth between prior-art references. Arguments by the Examiner are pure speculation without support.

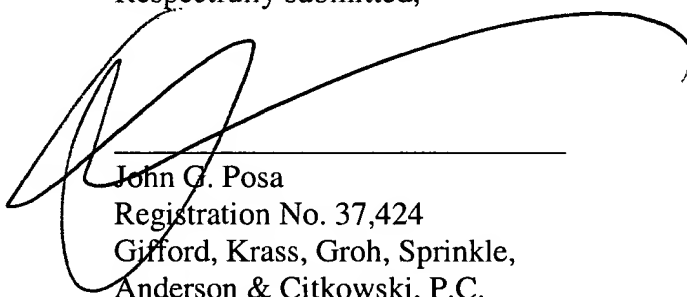
The Examiner goes on to state, for the first time, that “it is the examiner’s contention that one would look to modify David’s invention with Chang’s simply because both inventions deal with a conference call.” Again, the “Examiner’s contention” is not the standard for rejecting the claims of a patent application. The Examiner’s opinion has no bearing on this case. The Examiner further states that “It is notoriously well known in the art to modify wired systems(s) [sic] to be in a wireless environment.” First of all, which “art” is the Examiner talking about? Additionally, Appellants are not claiming the method of converting a wired system to be a wireless system; but rather, are claiming apparatus, including certain elements, which Appellants continue to believe are novel and non-obvious over the prior art. The Examiner’s oversimplification of the situation has once again led to the wrong conclusion. As a further example, the Examiner points to a claim limitation of Appellant’s which “simply reads ‘wherein the base unit forms part of a video teleconferencing system including a video camera for capturing images of the user for transmission to the listener through the telecommunication network’ – Chang clearly teaches this,” but that’s not all of the claim. Rather, claim 8 includes three elements, including at least one wireless remote microphone in wireless communication with a base unit enabling a user of the microphone to speak

to a listener to the base unit and telecommunications network. This is in combination with the statement which the Examiner contends Chang "clearly teaches." The dependent claims of the instant application, also under rejection, add further limitations which are neither taught nor suggested by the prior art.

In summary, this case should either be remanded to obtain a meaningful Office Action which utilizes the guidelines and rules in the MPEP, 37 CFR, and the Patent Act, or it should be allowed. The Examiner's statement that "It is the examiner's contention that there isn't anything novel about making a wireless system," is an example of a personal opinion about only one aspect of the invention, and cannot possibly serve as a comprehensive ground for rejection.

Respectfully submitted,

Dated: Jan. 17, 2005




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CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date indicated below and is addressed to: Mail Stop Appeal Brief, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date: Jan. 17, 2005



Sheryl L. Hammer